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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* LANE W. LEE, TIMOTHY R. FELDMAN,  
DOUGLAS M. RAYBURN, and GARY G. KIWIMAGI

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Appeal 2009-004942  
Application 09/939,896  
Technology Center 3600

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Decided: September 03, 2009

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Before JOSEPH A. FISCHETTI, BIBHU R. MOHANTY, and  
KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants seek our review under 35 U.S.C. § 134 of the final rejections of claims 36-40. We have jurisdiction under 35 U.S.C. § 6(b).

## SUMMARY OF THE DECISION

We REVERSE<sup>1</sup>.

## THE INVENTION

Appellants' claimed invention relates to a method for revoking a host device on a file-by-file basis. This revocation is based on a plurality of revocation lists stored on the media, such that one or more files on the requested media may have a revocation list associated with that file. This revocation list is accessed during a file access process rather than during an authentication process. (Spec. p. 31, ll. 15-19.)

Independent claim 36, which is deemed to be representative, reads as follows:

36. A method of revoking a host device on a file-by-file basis, comprising:

receiving at a storage engine a certificate from the host device, the certificate containing a digital signature;

authenticating the digital signature;

establishing a secure session by transmitting a session key to the host device; and

during the secure session:

receiving at the storage engine a file request from the host device,

the file request being directed to a file stored on a storage medium accessible to the storage engine;

reading a revocation list associated with the file from the storage medium, the revocation list containing at least one rule, the at least one rule associating data in the revocation list with data in the certificate;

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<sup>1</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed May 23, 2008) and Reply Brief ("Reply Br.," filed Oct. 14, 2008), and the Examiner's Answer ("Ans.," mailed Jul. 18, 2008).

applying the at least one rule on the data in the revocation list and the associated data in the certificate; and

if the application of the at least one rule provides a failing result, denying the file request.

### THE REJECTION

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Nonaka et al. 2003/0046238 A1 Mar. 6, 2003

The Examiner rejected claims 36-40 under 35 U.S.C. § 102(e) as being anticipated by Nonaka.

### ARGUMENTS

The Examiner took the position that Nonaka discloses the subject matter claimed in independent claim 36 and its dependents. (Ans. 3-5.) Additionally, Examiner argued that “a [secure application module (SAM)] may incorporate one file . . . . Thus, rejecting one SAM (i.e. one file) would comprise a ‘file-by-file’ revocation as claimed in claim 36.” (Ans. 10.)

Appellants argue *inter alia* that “Nonaka merely discloses a conventional revocation scheme rather than the claimed file-by-file revocation scheme . . . .” (App. Br. 7). Specifically, Appellants argue that in Nonaka, “the checking of the revocation list by the electronic music distribution (EMD) service center . . . occurs during registration of the SAM, not responsive to a file request by a host device. (Reply Br. 4) (emphasis omitted).

Rather than repeat the arguments of the Appellants or Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

## ISSUE

Have Appellants shown that the Examiner erred in rejecting claims 36-40 under 35 U.S.C. § 102(e) as anticipated by Nonaka?<sup>2</sup>

## FINDINGS OF FACT

The record supports the following findings of fact (FF) by at least a preponderance of the evidence. *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (explaining the general evidentiary standard for proceedings before the Office).

1. Nonaka is directed towards a system for distributing encrypted content data such as music to a data processing apparatus such as a media player. (Nonaka ¶ [0004].)
2. To use the system of Nonaka, a content provider creates a content file (CF) by encrypting data such as music or video. Subsequently, the end user is able to decode the encrypted CF using a media player containing a

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<sup>2</sup> Originally, Appellants' Brief contained two issues, however following entry of an after-final amendment, Examiner indicated the amendment removed the prior 35 U.S.C. § 112, second paragraph rejection. (Ans. 2.)

built-in secure application module (SAM). (Nonaka ¶¶ [0177], [0179], [0180], [0917].)

3. Nonaka's system provides data to users based on a subscription contract which enables their media player to decode the content data. (*Id.* ¶ [0004].)

4. In Nonaka, during registration and prior to decoding a CF, the SAM checks a revocation list by contacting an electronic music distribution (EMD) service center to determine whether the user has a valid subscription contract. (*Id.* ¶¶ [0670], [0671].)

5. Appellants' Specification describes that "the revocation list[] is accessed, not during an authentication process, but during a file access process." (Spec. p. 31, ll. 17-19.)

6. Prior to reading a revocation list, Appellants' method establishes a secure session. (App. Br. 11, Claims App'x claim 36.)

7. Each file may have its own revocation list associated with it. (Spec. p. 31, ll. 15-17.)

## PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987) (citation omitted).

## ANALYSIS

Appellants argue *inter alia* that Nonaka does not disclose at least the limitation “reading a revocation list associated with the file . . .” of claim 36. (App. Br. 7-9.)

Specifically, Appellants’ argue that in Nonaka, the secure application module (SAM) revocation is revoked with regard to the registration of the device and not based upon a file-by-file basis. (Reply Br. 4.)

In response to this argument, Examiner found, “[g]iven the broadest reasonable interpretation of the claims, a ‘file-by-file basis’ may comprise rejecting files of the same system . . .” (Ans. 10.) Additionally, Examiner found that “a SAM may incorporate one file, so rejecting one SAM would comprise rejecting one file.” (Ans. 10.) We disagree with the Examiner and find Appellants’ arguments to be compelling.

As Appellants suggest, Nonaka does not disclose at least the limitation “reading a revocation list associated with the file . . .” of claim 36. (App. Br. 7-9.)

We agree with Appellants and find that Nonaka reads a revocation list (FF 4), but this reading of a revocation list is performed initially during registration and associated with a device rather than a file. (FF 2, 4.)

In Nonaka, during initial registration, the SAM reads the revocation list to determine whether or not the device has a current subscription before entering a secure session. (FF 3, 4.) In contrast, Appellants’ claim 36 specifies that the reading of a revocation list is associated with the file and is performed after a secure session has been established with host device (FF 6), rather than during the initial registration in Nonaka (FF 4). This allows Appellants’ method to control not just general access to the content, but whether the user can access the content on

a file-by-file basis based on reading a plurality of revocation lists associated with each file during the secure session (FF 7). Therefore, while there are similarities in the aims of the present application and Nonaka, we do not find Nonaka to anticipate claims 36-40.

Accordingly, we conclude that Appellants have shown that Examiner erred in rejecting claim 36 under 35 U.S.C. § 102(e) as anticipated by Nonaka. As such, we find that the rejections of claims 37-40 were also made in error for the same reasons discussed *supra*.

#### CONCLUSION OF LAW

The decision of the Examiner rejecting claims 36-40 under 35 U.S.C. § 102(e) as anticipated by Nonaka, is reversed.

#### DECISION

The Examiner's rejections of claims 36-40 before us on appeal are REVERSED.

REVERSED

KMF

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